

REMARKS

I. Status of the Application

Claims 1-5 and 24-38 are pending in this application. In the March 9, 2006

Office action, the examiner:

- (i) allowed claims 32 and 33;
- (ii) objected to claims 24, 30, 31 and 36 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form;
- (iii) rejected claim 1 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,630,163 to Cooper et al. (hereinafter "Cooper");
- (iv) rejected claims 1 and 3 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,999,384 to Chen et al. (hereinafter "Chen");
- (v) rejected claim 2 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,549,161 to McTavish et al. (hereinafter, "McTavish");
- (vi) rejected claims 4, 5, 25-27, 34, 35, 37 and 38 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. patent no. 4,937,699 to Polgreen (hereinafter "Polgreen") in view of U.S. patent no. 6,210,232 to Lai et al. (hereinafter "Lai"); and
- (vii) rejected claims 4, 28 and 29 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cooper in view of Lai.

In this response, applicants have amended claims 1, 2, 4, 34, and 37, and applicants traverse the examiner's rejection of claims 1-5, 24-31 and 34-38.

II. The Examiner's Rejections Under 35 U.S.C. § 102(b) Should be Withdrawn

In the March 9, 2006 office action, the examiner rejected independent claims 1 and 2 under 35 U.S.C. § 102(b) as being anticipated by at least one of Cooper, Chen, or McTavish. As provided in MPEP § 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). In addition, the elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

A. Independent Claim 1

Neither Cooper nor Chen discloses all the limitations of claim 1. For example, with respect to amended claim 1, neither Cooper nor Chen discloses the limitation of "a voltage input *directly* coupled to the AC electrical *utility power line*" (emphasis added). As disclosed in the specification of the present application and in claim 1, the voltage input of the apparatus is directly coupled to a *utility* power line, which involves unique challenges. By contrast, Cooper and Chen only show devices configured for direct connection to typical consumer power lines that are not *utility* power lines. Accordingly, Cooper discloses connection of the disclosed device to a standard wall outlet (see FIG. 4, and col. 11, lines 45-56). Likewise, Chen discloses a device that serves as a wall

receptacle 10 or power strip (see Figs. 1, 4 and 5, and col. 4 lines 10-12 and 41-44). Thus, the disclosed arrangements of Cooper and Chen are directly connected to conductors provided within a consumer structure, but the arrangements are not *directly* connected to *utility* power lines as required by claim 1. Neither, neither Cooper nor Chen shows the “identical invention” of claim 1 shown in as complete of detail as claim 1, since there is no disclosure of a direct connection of a voltage input to an electrical *utility* power line. *See, e.g., Richardson v. Suzuki Motor Co.*, 868 F.2d at 1236. Accordingly, because neither Cooper nor Chen discloses all the limitations of claim 1, and do not disclose the identical invention as set forth in claim 1 in as complete of detail as claim 1, the examiner’s rejections of claim 1 under 35 U.S.C. § 102(b) should be withdrawn.

B. Independent Claim 2

McTavish does not disclose all the limitations of claim 2. For example, with respect to amended claim 2, McTavish does not disclose the limitation of “a voltage input directly coupled to the AC electrical utility power line” (emphasis added). By contrast, McTavish only shows a device configured for direct connection to a power source 101 (see Fig. 2 and col. 9, lines 3-6). There is no disclosure in McTavish of direct coupling of a voltage input to an electrical utility power line as required by claim 2. Furthermore, McTavish does not show the “identical invention” of claim 2 in as complete detail as claim 2, since there is no disclosure of a direct connection of a voltage input to an electrical utility power line. *See, e.g., Richardson v. Suzuki Motor Co.*, 868 F.2d at 1236. Accordingly, because McTavish does not disclose all the limitations of claim 2, the examiner’s rejection of claim 2 under 35 U.S.C. § 102(b) should be withdrawn.

C. Claims 3, 30, and 31

Dependent claims 3, 30 and 31 all depend from and incorporate all the limitations of one of allowable independent claims 1 or 2. Accordingly, it is respectfully submitted that dependent claims 3, 30 and 31 are also allowable for at least the same reasons that independent claims 1 and 2 are allowable.

III. The Examiner's Rejections Under 35 U.S.C. § 103(a) Should be Withdrawn

In the March 9, 2006 Office action, the examiner rejected claims 5, 25-27, 34, 35, 37 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Polgreen in view of Lai. In addition, the examiner rejected claims 4, 28, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Cooper in view of Lai. Applicant respectfully traverses the examiner's rejection of claims 4, 5, 25-29, 34, 35, 37 and 38 under 35 U.S.C. § 103(a). In particular, in order to make a *prima facie* case of obviousness, all claim limitations must be taught or suggested by the prior art. MPEP § 2143.03.

A. Independent Claims 4, 34 and 37

Applicant respectfully submits that at least the limitation found in each of claims 4, 34 and 37 of "a voltage input *directly* coupled to an electrical *utility* power line" (emphasis added) is not suggested or taught by the prior art. In particular, neither Polgreen, nor Cooper, nor Lai discloses "a voltage input *directly* coupled to an electrical *utility* power line" as required by claims 4, 34 and 37. As discussed previously, Cooper only shows a device configured for direct connection to typical consumer power lines

that are not *utility* power lines. Accordingly, Cooper discloses connection of the disclosed device to a standard wall outlet (see FIG. 4, and col. 11, lines 45-56). Similarly, neither Polgreen nor Lai make any disclose of a direct connection to utility power lines. Thus, because no single or combined disclosure of Polgreen, Cooper and/or Lai teaches “a voltage input *directly* coupled to an electrical *utility* power line” a *prima facie* case of obviousness under MPEP § 2142 is not made by the combination of Cooper or Polgreen and Lai for claims 4, 34 and 37. Accordingly, the examiner’s rejection of claims 4, 34, and 37 should be withdrawn.

For at least the reasons discussed above, a *prima facie* case has not been made that amended claims 4, 34 and 37 are unpatentable over some combination of Polgreen, Cooper and Lai. Accordingly, it is respectfully submitted that claims 4, 34, and 37 are allowable, and the examiner’s rejection of claims 4, 34 and 37 under 35 U.S.C. § 103(a) as obvious over Polgreen in view of Lai, and/or Cooper in view of Lai, should be withdrawn.

B. Dependent Claims 5, 25-29, 35 and 38

In the March 9, 2006 Office action, the examiner rejected dependent claims 5, 25-29, 35 and 38 under 35 U.S.C. § 103(a). Each of these claims depends from and incorporates all of the limitations of one of independent claims 4, 34 or 37. As set forth above, the examiner’s rejection of claims 4, 34 and 37 should be withdrawn. Therefore, because each of dependent claims 5, 25-27, 35 and 38 depend from and incorporate all of the limitations of one claim 4, 34 and 37, the examiner’s rejection of dependent claims 5, 25-27, 35 and 38 should also be withdrawn.

IV. Conclusion

For all of the foregoing reasons, it is respectfully submitted the applicant has made a patentable contribution to the art. Favorable reconsideration and allowance of this application, including pending claims 1-5 and 24-38, is therefore respectfully requested.

In the event applicant has inadvertently overlooked the need for an extension of time or payment of an additional fee, the applicant conditionally petitions therefore, and authorizes any fee deficiency to be charged to deposit account 13-0014.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Russ Fowler", with a long horizontal flourish extending to the right.

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